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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,649	12/28/1999	AMY MULDERY	07019.0004	1261

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,649

Applicant(s)

Mulderry et al.

Examiner

O'Connor

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sept. 26, 2003 (RCE and Amdt "B") and Oct. 24, 2003 (Amdt "C").
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec. 28, 1999 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on September 26, 2003 (Paper N^o 19) and October 24, 2003 (Paper N^o 21) have been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on September 26, 2003 (Paper N^o 19) and October 24, 2003 (Paper N^o 21) in reply to the Office action mailed May 28, 2003 and the interview of October 15, 2003.
3. The amendment of claims 1, 3, 6, and 7 by applicant in Paper N^o 19 is hereby acknowledged.
4. The further amendment of claims 1 and 7 by applicant in Paper N^o 21 is hereby acknowledged.
5. The cancellation of claims 10-31 by applicant in Paper N^o 21 is hereby acknowledged.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 5,926,796), in view of Watanabe et al. (US 5,543,607).

Walker et al. disclose a method of completing a plurality of transactions on a computer network involving at least one customer computer and a plurality of merchant computers, said method comprising the following steps:

transmitting an offer (to buy a single issue of a magazine for a particular price) from a first merchant computer 122 to a customer 110 computer 120 (the computer provided to interface with the customer 110 and process the customer's 110 transactions);

transmitting customer-inputted information (name and method of payment) from the customer computer 120 to the first merchant computer 122 in response to the offer;

utilizing the customer-inputted information to process 1335 the offer, wherein said customer-inputted information contains a payment method (method of payment) and customer identification data (customer name) required by said first merchant to process said offer;

transmitting 1325 to said customer computer 120 a second offer from a second merchant computer 130 (an offer to buy a subscription to the magazine, it being considered inherent that the subscription offers are provided from the magazine publishers to the retailer to sell); and,

transmitting said customer-inputted information from said first merchant computer 122 to said second merchant computer 130, provided said customer computer 120 accepts said second offer,

but the customer computer of Walker is operated by a store clerk rather than directly operated by the customer, the customer information being inputted by the customer to the store clerk who then actually keys in the data into the customer computer.

However, Watanabe et al. show a similar customer computer to the customer computer of Walker et al., except that the customer computer of Watanabe et al. is indeed operated directly by the customer, rather than by the store clerk.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Walker et al. so as to have the customer computer operated directly by the customer rather than operated by a store clerk, in accordance with the teachings of Watanabe et al., in order to improve efficiency by employing fewer store clerks, thereby reducing operating costs and increasing profits.

Regarding claims 2, 4, 8, and 9, Walker et al. disclose that the step of transmitting an offer is further comprised of the following steps:

sending 370 an offer from said second merchant computer 130 to said first merchant computer 122;

storing 342 said offer on said first merchant computer 122 (see, in particular, Fig. 3); and, presenting said offer 1325 by said first merchant computer 122 to said customer computer 120 (see, in particular, Fig. 13).

Regarding claims 3 and 5, the method of Walker et al. further comprises the following steps: processing said customer-inputted information by said second merchant computer 130; and, causing a predetermined number of issues of a periodical to be delivered 1550 to a customer associated with said customer-inputted information (see, in particular, Figs. 14 and 15).

Regarding claim 6, the method of Walker et al. further comprises the step of automatically debiting a customer account (it being inherent that the publisher maintains an account for each customer containing the number of remaining issues owed to the customer) corresponding to said customer-inputted information after said predetermined number of issues have been delivered (debiting the account of issues-owed by one issue after each additional issue is delivered), provided said customer does not cancel future delivery of said periodical (see, in particular, column 12, lines 6-53).

Response to Arguments

8. Applicant's arguments filed September 26, 2003 and October 24, 2003 have been fully considered but are not persuasive.

9. The arguments regarding the previous prior art rejection have been considered, but have been rendered moot by applicant's amendments, and the consequent new grounds of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 11, 2003

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "12-11-03" written in a similar style.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627